

prejudice, and claims 44-50 are added. Claims 1-18 and new claims 44-50 are presented by Applicants for reconsideration and allowance.

### **I. RESTRICTION/ELECTION REQUIREMENT**

Page 2 of the Office Action includes a Restriction/Election Requirement requiring the election of one of four inventions under 35 U.S.C. § 121. In response to the Restriction/Election Requirement, Applicants hereby affirms the election of the claims of Group I, Claims 1-18, for prosecution in the subject application.

Applicants, of course, reserve the right to file a divisional application covering the subject matter of the non-elected claims and are filing such a divisional application concurrently with this Reply.

### **II. INVENTORS**

The inventors of claims of Group I, and the added claims 44-50, are ~~Richard P. Hulock and Mark W. Lin~~ as shown on the list of inventors in the Declaration originally filed with the present application. ~~Richard P. Hulock and Mark W. Lin~~ are not co-inventors of the invention of the claims of Group I and claims 44-50. Accordingly, please remove Richard P. Hulock and Mark W. Lin as inventors of the present invention as amended with this Reply.

### **III. REJECTION OF CLAIMS 1-18 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HUTIN.**

Page 5 of the Office Action rejected claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over Hutin (U.S. Patent No. 5,586,947). Claims 1 and 13 are independent claims and claims 2-12 and 14-18 depend from claims 1 and 13, respectively. Independent claims 1 and 13 are believed to be patentably distinguishable over the cited prior art.

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*Independent Claim 1:*

Independent claim 1 recites a golf club head including a front wall, a sole portion and a resilient insert assembly. The front wall includes a rearwardly sloped front strike side and a rear side. The rear side has an upper region and a lower region. The sole portion rearwardly extends from the lower region of the rear side. The rear side and the sole portion define a forwardly extending cavity and a recess. The recess downwardly extends into the sole portion and interconnects with the cavity. The insert assembly is positioned in and substantially fills the recess. The insert assembly is coupled to at least the sole portion or the lower region of the rear side. The upper region of the rear side is generally uncovered. The insert assembly is fabricated of at least one material. The material has a durometer of between 20 on a Shore A hardness scale and 75 on a Shore D hardness scale.

Applicants respectfully submit that claim 1 is patentable and non-obvious over the cited prior art. Hutin does not disclose, teach or suggest the golf club head of claim 1. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the cited prior art. MPEP Section 2143.03; *In re Royka*, 490 F.2d 981 (CCPA 1974). In particular, Hutin does not disclose, teach or suggest at least the following limitations of claim 1. Hutin does not disclose, teach or suggest a front wall and a sole portion of a club head defining a forwardly extending cavity and a recess downwardly extending into the soleplate, wherein a resilient insert assembly substantially fills the recess. Further, Hutin does not disclose, teach or suggest the front wall of the club head including a rear side having an upper region and a lower region, wherein the upper region of the rear side is generally uncovered by the insert assembly.

In contrast, Hutin discloses a golf club head having only a forwardly extending cavity and a vibration damper including a rigid constraining plate and a visco-elastic high damping sheet. The golf club head of Hutin does not include a recess downwardly extending into the sole plate, and even if one were to conclude that Hutin does include a recess, Hutin

does not teach, suggest or disclose the vibration damper substantially filling the recess. The golf club head of Hutin includes a rear surface that is generally covered by the vibration damper. In particular, an upper region of the rear surface of Hutin is generally covered by the vibration damper. Claim 1 of the present invention requires the upper region of the rear surface of the front wall to be generally uncovered.) Thus, Applicants respectfully submit that independent claim 1 is non-obvious over, and overcomes the rejection based upon, Hutin. Claims 2-12 directly and indirectly depend from independent claim 1 and are believed to be patentable over Hutin for at least the same reasons.

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page 9-10

*Independent Claim 13:*

Independent claim 13 recites a golf club head including a front wall, a sole portion, a first insert and a second insert. The front wall includes a rearwardly sloped front strike side and a rear side. The sole portion rearwardly extends from a lower region of the rear side. The rear side and the sole portion define a forwardly extending cavity and a recess. The recess downwardly extends into the sole portion and interconnects with the cavity. The second insert contacts the first insert. The first and second inserts are positioned in and collectively substantially fill the recess. At least one of the first and second inserts is attached to at least one of the sole portion and the lower region of the rear side. The first and second inserts are made of first and second elastomeric materials.

Applicants respectfully submit that claim 13 is patentable and non-obvious over the cited prior art. Hutin does not disclose, teach or suggest the golf club head of claim 13. In particular, Hutin does not disclose, teach or suggest at least the following limitations of claim 1. Hutin does not disclose, teach or suggest a front wall and a sole portion of a club head defining a forwardly extending cavity and a recess downwardly extending into the soleplate, wherein a resilient insert assembly substantially fills the recess. Further, Hutin does not disclose, teach or suggest first and second inserts made of first and second elastomeric materials.

Agree

In contrast, Hutin discloses a golf club head having only a forwardly extending cavity and a vibration damper. The golf club head of Hutin does not include a recess downwardly extending into the sole plate, and even if one were to conclude that Hutin does include a recess, Hutin does not teach, suggest or disclose first and second inserts substantially filling the recess. The vibration damper of Hutin includes a rigid constraining plate and a visco-elastic high damping sheet. Hutin discloses the rigid constraining plate being formed of an aluminum alloy and does not teach or suggest the rigid constraining plate being formed of a second elastomeric material. Thus, Applicants respectfully submit that independent claim 13 is non-obvious over, and overcomes the rejection based upon, Hutin. Claims 14-18 directly and indirectly depend from independent claim 13 and are believed to be patentable over Hutin for at least the same reasons. Agree

### III. ADDED CLAIMS

With this Reply claims 44-50 are added. Claim 44 is an independent claim and claims 45-50 depend from claim 44. Claims 44-50 are believed to be patentably distinguishable over the cited prior art.

Claim 44 is directed to a golf club head including a front wall, a sole portion, and a resilient insert assembly. The front wall includes a rearwardly sloped front strike side and a rear side. The rear side has an upper region and a lower region. The sole portion rearwardly extends from the lower region of the rear side. The sole portion includes an upwardly extending rear wall. The rear side defines a forwardly extending cavity. The lower region of the rear side of the front wall, the rear wall and the sole portion define a recess. The recess is interconnected with the cavity and is open only in an upward direction. The insert assembly is positioned in and substantially fills the recess. The insert assembly is coupled to at least one of the sole portion and the lower region of the rear side. The upper region of the rear side is generally uncovered.

V. CONCLUSION

Applicants respectfully request reconsideration of claims 1-18 and new claims 44-50 for the reasons stated above. Applicants believe that the present application is now in condition for allowance. Favorable reconsideration under 37 C.F.R. § 1.112 is respectfully requested. The Examiner is invited to telephone the undersigned at (847) 472-6104 to discuss any issues in this case in order to advance the prosecution thereof.

The Commissioner is authorized to charge any additional fee deficiencies or credit any overpayment to Deposit Account No. 501959.

Respectfully submitted,

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**ATTACHMENT A  
CURRENTLY PENDING CLAIMS**

- 1           1.       (Unchanged) A golf club head comprising:  
2                   a front wall including a rearwardly sloped front strike side and a rear side, the  
3 rear side having an upper region and a lower region;  
4                   a sole portion rearwardly extending from the lower region of the rear side, the  
5 rear side and the sole portion defining a forwardly extending cavity and a recess, the recess  
6 downwardly extending into the sole portion and interconnected with the cavity; and  
7                   a resilient insert assembly positioned in and substantially filling the recess, the  
8 insert assembly coupled to at least one of the sole portion and the lower region of the rear side,  
9 the upper region of the rear side being generally uncovered, the insert assembly being  
10 fabricated of at least one material, the material having a durometer of between 20 on a Shore A  
11 hardness scale and 75 on a Shore D hardness scale.
- 1           2.       (Unchanged) The golf club head of claim 1 wherein the at least one material  
2 has a durometer of between 70 on a Shore A hardness scale and 60 on a Shore D hardness scale.
- 1           3.       (Unchanged) The golf club head of claim 1 wherein the insert assembly  
2 includes at least first and second inserts.
- 1           4.       (Unchanged) The golf club head of claim 3 wherein the first insert is  
2 positioned substantially forward of the second insert within the recess.
- 1           5.       (Unchanged) The golf club head of claim 3 wherein the first and second inserts  
2 are made of first and second materials respectively and wherein the second material has a  
3 durometer that is greater than the durometer of the first material.
- 1           6.       (Unchanged) The golf club head of claim 5 wherein the first material has a  
2 durometer of between 70 and 80 on a Shore A hardness scale and wherein the second material  
3 has a durometer of between 50 and 60 on a Shore D hardness scale.

1           7.       (Unchanged) The golf club head of claim 3 wherein the first insert includes a  
2 first rear surface and the second insert includes a second front surface and wherein the first rear  
3 surface engages the second front surface.

1           8.       (Unchanged) The golf club head of claim 7 wherein the first rear surface of the  
2 first insert has at least one rearwardly extending projection and defines at least one forwardly  
3 extending indentation and wherein the second front surface of the second insert has at least one  
4 corresponding forwardly extending projection and defines at least one corresponding  
5 rearwardly extending indentation.

1           9.       (Unchanged) The golf club head of claim 8 wherein the at least one rearwardly  
2 extending projection and the at least one forwardly extending projections each have an end  
3 shape selected from the group consisting of a squared end, a triangular end, an arcuate end, a  
4 polygonal end, irregular end and combinations thereof.

1           10.      (Unchanged) The golf club head of claim 1 wherein the insert assembly is  
2 affixed to at least one of the sole portion and the lower region of the rear side.

1           11.      (Unchanged) The golf club head of claim 3 wherein the first and second inserts  
2 are each formed of a material selected from the group consisting of a thermoplastic, a  
3 thermoset material, an elastomer, a urethane, a polyurethane, a plastic and combinations  
4 thereof.

1           12.      (Unchanged) The golf club head of claim 1 wherein the insert assembly has an  
2 exposed surface and wherein the insert assembly includes a cap covering at least a portion of  
3 the exposed surface.

1           13.      (Unchanged) A golf club head comprising:  
2                   a front wall including a rearwardly sloped front strike side and a rear side;  
3                   a sole portion rearwardly extending from a lower region of the rear side, the  
4 rear side and the sole portion defining a forwardly extending cavity and a recess, the recess  
5 interconnected with the cavity and downwardly extending into the sole portion;  
6                   a first insert; and

7                   a second insert contacting the first insert, the first and second inserts positioned  
8 in and collectively substantially filling the recess, at least one of the first and second inserts  
9 attached to at least one of the sole portion and the lower region of the rear side, the first and  
10 second inserts made of first and second elastomeric materials, respectively.

1           14.     (Unchanged) The golf club head of claim 13 wherein the first insert has a first  
2 rear surface, wherein the second insert has a second front surface, and wherein the first rear  
3 surface matably engages the second front surface.

1           15.     (Unchanged) The golf club head of claim 14 wherein the first rear surface of  
2 the first insert has at least one rearwardly extending projection and defines at least one  
3 forwardly extending indentation and wherein the second front surface of the second insert has  
4 at least one forwardly extending projection and defines at least one rearwardly extending  
5 indentation.

1           16.     (Unchanged) The golf club head of claim 15 wherein the at least one  
2 rearwardly extending projection and the at least one forwardly extending projections each have  
3 an end shape selected from the group consisting of a squared end, a triangular end, an arcuate  
4 end, a polygonal end, irregular end and combinations thereof.

1           17.     (Unchanged) The golf club head of claim 13 wherein the first and second  
2 inserts are each formed of a material selected from the group consisting of a thermoplastic, a  
3 thermoset material, an elastomer, a urethane, a polyurethane, a plastic and combinations  
4 thereof.

1           18.     (Unchanged) The golf club head of claim 13 wherein the insert assembly has  
2 an exposed surface and wherein the insert assembly includes a cap covering at least a portion of  
3 the exposed surface.

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Claims 19 - 43 are cancelled without prejudice.

1           44.     (New) A golf club head comprising:

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2 a front wall including a rearwardly sloped front strike side and a rear side, the  
3 rear side having an upper region and a lower region;

4 a sole portion rearwardly extending from the lower region of the rear side, the  
5 sole portion including an upwardly extending rear wall, the rear side defining a forwardly  
6 extending cavity, the lower region of the rear side, the rear wall of the sole portion and the sole  
7 portion defining a recess, the recess interconnected with the cavity and being open only in an  
8 upward direction; and

9 a resilient insert assembly positioned in and substantially filling the recess, the  
10 insert assembly coupled to at least one of the sole portion and the lower region of the rear side,  
11 the upper region of the rear side being generally uncovered.

1 45. (New) The golf club head of claim 44 wherein the insert assembly is fabricated  
2 of at least one material, and wherein the material has a durometer of between 20 on a Shore A  
3 hardness scale and 75 on a Shore D hardness scale.

1 46. (New) The golf club head of claim 45 wherein the at least one material has a  
2 durometer of between 70 on a Shore A hardness scale and 60 on a Shore D hardness scale.

1 47 (New) The golf club head of claim 45 wherein the insert assembly includes  
2 first and second inserts, wherein the first and second inserts are made of first and second  
3 materials respectively, and wherein the second material has a durometer that is greater than the  
4 durometer of the first material.

1 48. (New) The golf club head of claim 47 wherein the first material has a  
2 durometer of between 70 and 80 on a Shore A hardness scale and wherein the second material  
3 has a durometer of between 50 and 60 on a Shore D hardness scale.

1 49. (New) The golf club head of claim 47 wherein the first and second inserts are  
2 each formed of a material selected from the group consisting of a thermoplastic, a thermoset  
3 material, an elastomer, a urethane, a polyurethane, a plastic and combinations thereof.

- 1        50.    (New) The golf club head of claim 19 wherein the insert assembly has  
2    an exposed surface and wherein the insert assembly includes a cap covering at least a  
3    portion of the exposed surface.
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(Cont)